

REMARKS

Favorable reconsideration of this application, in light of the present amendments and the following discussion, is respectfully requested.

Claims 33, 34, 37-57, 60-71, 74-84, 87-96, and 99-119 are pending; Claims 109-119 are newly added; and Claims 1-32, 35-36, 58-59, 72-73, 85-86, and 97-98 were previously canceled. It is respectfully submitted that no new matter is added by this amendment, as support for new Claims 109-119 may be found, for example, in the specification at pages 22-24.

In the outstanding Office Action, Claims 33, 34, 37-55, and 63¹ were rejected under 35 U.S.C. § 103(a) as unpatentable over Goldstein (U.S. Pat. No. 5,410,326) in view of Fajkowski (U.S. Pat. No. 5,905,246); Claims 56, 57, 60-71, 74-84, 87-96, and 99-108 were rejected under 35 U.S.C. § 103(a) as unpatentable over Goldstein in view of Fajkowski, and further in view of Kishtaka (U.S. Pat. No. 6,084,643); and Claim 37 was rejected under 35 U.S.C. § 103(a) as unpatentable over Goldstein in view of Fajkowski, and further in view of Maa (U.S. Pat. No. 5,818,935).

With regard to the rejections of Claims 33, 34, and 37-55, this rejection is respectfully traversed.

Independent Claim 33 recites (in part):

a receiver for receiving the additional information transmitted by the electric apparatus, an output unit for outputting the additional information ... to a display device ... wherein the additional information includes advertisement information [and] the advertisement information includes coupon information.

¹ Applicants note that Claim 63 depends from Claim 62, and Claim 62 was not identified as rejected by Goldstein in view of Fajkowski. As the Office Action relies upon Kishtaka to reject the features of Claim 62, it is respectfully submitted that Claim 63 could not be anticipated by the combination of Goldstein and Fajkowski. Therefore, it seems that Claim 63 is listed in error as rejected by the combination of Goldstein and Fajkowski.

Independent Claims 47-49, 53-56, 70, 83, and 95 recite analogous features. As described in the specification at pages 29-32, the claimed limitations enable a broadcaster to communicate advertisement information, such as a coupon, directly to a user via a remote device, such as a television remote control.

Goldstein relates to a programmable remote control device for interacting with a plurality of remotely controlled devices. Goldstein describes handheld device that permits the automated dialing of a telephone number based on the actuation of a preprogrammed switch of the device.²

As admitted in the outstanding Office Action at page 3, Goldstein fails to disclose or suggest coupon information. The outstanding Office Action attempts to remedy this deficiency by relying upon Fajkowski.

Fajkowski relates to a method and apparatus for coupon management and redemption. In the system of Fajkowski, the coupon card is placed in the adaptor's insertion port, and the adaptor is placed in the computer's disk drive. The magnetic head in the disk drive will transmit the coupon information to the magnetic head of the adaptor. The adaptor then transmits the coupon information to the coupon card for the adaptor's communication port.³

As is evident from this description, Fajkowski relates to a user searching for coupons, manually transferring them via a computer to a transportable memory, and taking the coupons to the store for use when checking out. Fajkowski in no way discloses or suggests providing coupon information to a remote device used for controlling an electric apparatus.

This is a notable aspect of the Applicants' invention. For example, the consumer using the apparatus of Fajkowski is very different from the consumer who is likely to use the apparatus of Goldstein. Specifically, the consumer of Fajkowski is much more focused and

² Goldstein, Abstract.

³ Fajkowski, col. 6, lines 37-43.

cost conscious as compared to a typical television viewer and proactively seeks cost savings for products he/she is interested in purchasing. Thus, when the coupon of Fajkowski is actually presented, the user has selected the goods or services with the coupon already in his possession.

By contrast, the user of the present invention is viewing a broadcast when presented with the coupon. The coupon may relate to a discount on a product or a pay per view television show, for example. The user does not have to make a special effort to seek out and store the coupon, and may not previously have been interested in acquiring the goods or services represented by the coupon. Thus, the presentation of the coupon in this environment can influence purchase decisions which may not otherwise be made absent such interactive incentives.

Simply stated, as recited in Claim 33, an exemplary embodiment of the present invention is capable of capturing the interest of the impulse buyer, which is much different than the predetermined coupon selection and presentation of Fajkowski.

Thus, it is evident that combining the teachings of Fajkowski with Goldstein is the result of hindsight reconstruction. It is only in light of the present specification that such a combination would become obvious, as the present specification illustrates the numerous benefits achieved by presenting coupons to television viewers for redemption through their remote control devices. Accordingly, it is respectfully submitted that the outstanding Office Action fails to provide a *prima facie* case of obviousness, and it is respectfully requested that this rejection be withdrawn.

With regard to the rejection of Claims 56, 57, 60-71, 74-84, 87-96, and 99-108 under 35 U.S.C. § 103(a) as unpatentable over Goldstein in view of Fajkowski and further in view of Kishtaka, this rejection is respectfully traversed.⁴

Kishtaka issued as a U.S. patent application on July 4, 2000, prior to the December 29, 2000 filing date of the present application, which qualifies this reference as 102(a) art. However, Applicants note that in a response filed November 5, 2003, the application priority date of July 18, 1997 was perfected. Accordingly, Kishtaka does not qualify under 35 U.S.C. § 102(a) or any other statutory class of prior art.

It is therefore respectfully submitted that the Office Action has failed to provide a *prima facie* case of obviousness. Accordingly, it is respectfully requested that the rejection relying on Kishtaka be withdrawn.

With regard to the rejection of Claim 37 under 35 U.S.C. § 103(a) as unpatentable over Goldstein in view of Fajkowski, and further in view of Maa, that rejection is respectfully traversed.

The features of Claim 37 were previously addressed with regard to the combination of Goldstein and Fajkowski above. As Maa is not relied upon to provide the features identified as deficient in the combination of Goldstein and Fajkowski, Maa is not substantively addressed herewith, and it is respectfully requested that this rejection be withdrawn.

Newly added Claims 109-119 recite that the additional information is included in a multimedia broadcast signal. This feature is not believed to be disclosed or suggested by the references of record, and it is respectfully submitted that Claims 109-119 patentably distinguish over the cited references for at least the reasons set forth with regard to the independent claims from which Claims 109-119 depend.

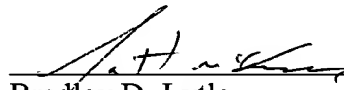
⁴ Although the Office Action refers to Takahashi at page 7, Examiner Wesner clarified that the rejection based on Kishtaka during a telephone conversation on February 20, 2004.

As Applicants have not amended the claims in response to any rejection on the merits, a further rejection of these claims based upon newly cited prior art in the next communication **cannot properly be considered a Final Office Action.**

Consequently, in view of the foregoing discussion, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Respectfully submitted,

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